

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Avigdor SCHERZ <i>et al.</i>	Docket No. 383988-006US (109599)
Serial No. 10/534,692	Group Art Unit: 1624
Filed: November 9, 2005	Confirmation No. 8697
For: WATER SOLUBLE ANIONIC BACTERIOCHLOROPHYLL DERIVATIVES AND THEIR USES	Examiner: Paul V. WARD

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(b)

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

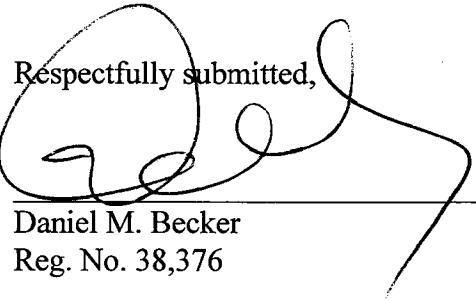
Sir:

This is a request for reconsideration of the patent term adjustment of 505 days set forth in the determination of Patent Term Adjustment attached to the Notice of Allowance mailed on September 22, 2010 for the above-referenced patent application. It is respectfully requested that Applicants be granted a minimum patent term adjustment of 1477 days, which may be extended or reduced based on the actual date of issuance of a patent from the above-referenced application, for the reasons set forth in the “Statement Under 37 C.F.R. §1.702(b)(2)” attached hereto. The issue fee is being paid concurrently.

In accordance with 37 C.F.R. §1.705(b)(1), please charge the fee set forth in 37 C.F.R. §1.18(e) to Dechert LLP Deposit Account No. 50-2778 (**Order no. 383988-006US (109599)**). No other fees are believed to be due, but the Director is authorized to charge any additional fees, or credit any refunds, to Dechert LLP Deposit Account No. 50-2778 (**Order no. 383988-006US (109599)**).

Applicants respectfully request grant of this application.

Respectfully submitted,


Daniel M. Becker

Reg. No. 38,376

Date: NOVEMBER 2, 2010

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STATEMENT UNDER 37 C.F.R. § 1.705(b)(2)

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 C.F.R. § 1.705(b)” for the above-referenced patent application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of 1477 days, which may be extended or reduced based on the actual date of issuance of a patent from the above-referenced application.

The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) that was attached to the Notice of Allowance (submitted herewith as Exhibit A) is 505 days. That determination projected that the patent would issue on the Tuesday before the date that is 28 weeks after September 22, 2010, the mailing date of that notice (*i.e.*, April 5, 2011). A copy of the Office’s calculation of 505 days, printed from PAIR, is submitted herewith as Exhibit B.

This determination of 505 days is in error because it fails to calculate any “B” delay or Overlapping Delay under 37 C.F.R. §§ 1.702(b), 1.703(b), and 1.703(f).

A. “A” Delay under 37 C.F.R. §§ 1.702(a) and 1.703(a)

Applicants are entitled to a period of patent term adjustment pursuant to 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) (“‘A’ delay”). Applicants agree with the Office’s calculation shown in Exhibit B that the “‘A’ delay is 575 days. Because the Office failed to mail an action under 35 U.S.C. § 132 until August 6, 2008, Applicants are entitled to a period of patent term adjustment beginning on the day after the date that is 14 months after the date on which the above-referenced application fulfilled the requirements of 35 U.S.C. § 371, *i.e.*, January 10, 2007, and ending on the date of mailing of an action under 35 U.S.C. §132, *i.e.*, August 6, 2008, or 575 days.

B. “B” Delay under 37 C.F.R. §§ 1.702(b) and 1.703(b)

Applicants are entitled to a period of patent term adjustment pursuant to 37 C.F.R. §§ 1.702(b) and 1.703(b) due to examination delay equal to the number of days in the period beginning on the day after the date that is three years after the national stage commenced under 35 U.S.C. 371(b) or (f) and ending on the date a patent is issued, not including several categories of exceptions stated in 35 U.S.C. § 254(b)(1)(B)(i)-(iii) (“‘B’ delay”). Applicants disagree with the Office’s failure to calculate “‘B’ delay.

1. Start of the “B” Delay

Under 35 U.S.C. § 154(b)(2)(B), the “‘B’ delay is to begin on the day following the day that is “3 years after the actual filing date of the application in the United States.” The regulations interpret that date to be that which is “three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.” 37 C.F.R. §§ 1.702(b), 1.703(b).

The national stage began on May 17, 2005, which is the date that is 30 months after the earliest priority claimed, as outlined in 35 U.S.C. § 371(b). The fact that the requirements of 35 U.S.C. § 371(c) may not have been met until November 9, 2005 is immaterial because the 30-

month anniversary date precedes the § 371(c) date. *See* 35 U.S.C. §§ 371(b) & (f). Thus, under the regulations, the “B” delay begins to accrue on May 18, 2005.

However, by keying the start of the “B” delay for an international application to the date that the application enters the U.S. national stage, 37 C.F.R. §§ 1.702(b) and 1.703(b) do not faithfully implement the requirements of statute. The statute does not discuss the start of the national stage, but instead makes “B” delay accrue based upon the “actual filing date of the application in the United States.” Here, the applicant actually filed its application (with a 35 U.S.C. § 371(f) request) on May 13, 2005, which was four days *before* the 30-month anniversary of the priority claim, and consequently four days *before* the entry onto the U.S. national stage. Thus, under the plain language of the statute, any “B” delay should begin to accrue on May 14, 2008, which is the day after the 3-year anniversary of the applicant’s actual filing of the application in the United States.

2. End of the “B” delay

The Office estimated in Exhibit A that the patent would issue on the Tuesday preceding the day that is 28 weeks from when the notice of allowability was mailed, which is April 5, 2011.

A request for continued examination (“RCE”) was filed under 35 U.S.C. § 132 on July 23, 2010. Thus, under 37 C.F.R. § 1.703(b)(1), the “B” delay would accrue only until July 22, 2010.

However, the amount of “B” delay should not be limited by 37 C.F.R. § 1.703(b)(1), because that rule conflicts with the plain language of 35 U.S.C. § 154(b)(1)(B). The statute reads:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the [PTO] to issue a patent within 3 years after the actual filing date of the application in the United States, not including-

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) . . . ;
- (iii) . . . ,

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

This plain language both contains a “trigger,” which determines *whether or not* “B” delay should apply at all (*i.e.*, “if the issue of an original patent is delayed due to the failure of the [PTO] to issue a patent within 3 years after the actual filing date of the application in the United States”), and contains a “remedy,” which determines *how much* patent term adjustment is to be awarded if the trigger condition is met (*i.e.*, the flush language following 35 U.S.C. § 154(b)(1)(B)(iii), which reads, “the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued”). The trigger is reflected in the corresponding regulations at 37 C.F.R. § 1.702(b), and the remedy is reflected at 37 C.F.R. § 1.703(b).

35 U.S.C. § 154(b)(1)(B) contains three exceptions, only the first of which is relevant here. *See* 35 U.S.C. § 154(b)(1)(B)(i)-(iii). The first exception (the “RCE Exception”) concerns the filing for a request for continued examination under 35 U.S.C. § 132(b). It provides that the three years provided under the trigger shall not include “(i) any time consumed by continued examination of the application requested by the applicant under section 132(b).” The regulations erroneously apply the RCE Exception *not only* to the trigger *but also* to the remedy. *See* 37 C.F.R. § 1.702(b)(1) (RCE Exception applied to the trigger), 37 C.F.R. § 1.703(b)(1) (RCE Exception applied to remedy).

The plain language of the statute, however, makes it clear that the RCE Exception applies only to the trigger, and *not* to the remedy. The natural reading of the “not including” language that introduces all three exceptions is that this language modifies the wording immediately

preceding it (*i.e.*, modifies the trigger). If Congress had instead intended that the RCE Exception should modify the remedy (*i.e.*, as reflected in 37 C.F.R. § 1.703(b)(1)), then the statute would have put the “not including” language in the definition of the remedy provision, rather than in the language preceding it. Alternatively, had Congress intended the RCE Exception to serve as an overall limitation applicable to both the trigger and the remedy, then the statute would have included the exceptions as part of the overall limitation that already precedes the entire section (*i.e.*, “Subject to the limitations under paragraph (2), . . .”).

The interpretation that the RCE Exception applies *only* to the trigger, and *not* the remedy, is not only supported by the plain language of the statute, but it also is confirmed by the legislative history. As the Conference Committee reported,

[D]ay-for-day restoration of term is granted if the USPTO has not issued a patent within three years after “the actual date of the application in the United States.” . . . Any periods of time - (1) consumed in the continued examination of the application under § 132(b) of the Patent Act as added by section 4403 of this Act; . . . shall not be considered delay by the USPTO and *shall not be counted for purposes of determining whether the patent issued within three years from the actual filing date.*

145 Cong. Rec. H11802-03 (Nov. 9, 1999) (Joint Explanatory Statement of the Committee of Conference included with the statement of Rep. Tauzin) (emphasis added); *see also* 145 Cong. Rec. S14718 (Nov. 17, 1999) (identical statement by the sponsor in the Senate, Sen. Lott). This legislative history makes clear that the continued examination of the application is relevant to determining “whether the patent issued within three years from the actual filing date,” but *not* for calculating the adjustment in the event the patent is not issued during that term.

Moreover, the phrase “that 3-year period” appearing in the remedy does not serve to incorporate the RCE Exception from the trigger into the remedy. When an RCE is filed more than three years after the application was filed, then the end of “that 3-year period” is the date is on the third anniversary of the actual filing date or national stage entry. Thus, “each day after the end of that 3-year period until the patent is issued” must necessarily include every day after the

three year filing or national stage anniversary until the issue date, regardless of whether an RCE is filed during that period or not.

Finally, applying the RCE exception to the trigger, but not to the remedy, does not create some “patent term windfall” for patentees. It merely ensures that the patentees enjoy a minimum of the same 17-year term that they would have enjoyed prior to the amendments to the patent term made to comply with the Uruguay Round of the GATT. Again, the legislative history demonstrates that Congress foresaw the need for such patent term adjustment and encouraged it “for good measure.” As the congressional conference committee put it,

Accordingly, subtitle D [of the American Inventors Protection Act] . . . adds a new provision to compensate applicants fully for USPTO-caused administrative delays, and, for good measure, includes a new provision guaranteeing diligent applicants at least a 17-year term by extending the term of any patent not granted within three years of filing. Thus, no patent applicant diligently seeking to obtain a patent will receive a term of less than 17 years as provided under the pre-GATT standard; in fact, most will receive considerably more.

145 Cong. Rec. H11802 (Nov. 9, 1999) (Joint Explanatory Statement of the Committee of Conference included with the statement of Rep. Tauzin) (footnote omitted); *see also* 145 Cong. Rec. S14718 (Nov. 17, 1999) (identical statement by the sponsor in the Senate, Sen. Lott). Indeed, if the Office believes that patentees are “gaming the system” by filing RCEs after three years, then the Director may issue substantive regulations classifying such behavior as one of the “circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application” and to limit patent term adjustment in that way. *See* 35 U.S.C. § 154(b)(2)(C)(iii). The Director has not issued such substantive regulations here, however, and there is no evidence that anyone here was engaged in any such conduct.

In view of the foregoing, the RCE Exception does not apply to the remedy in 35 U.S.C. § 154(b)(1)(B) (“the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued”), and thus 37 C.F.R. § 1.703(b)(1) does not comport with the statute and must not be applied when determining the amount of “B” delay. Thus, the “B” delay should accrue until the patent issues, currently estimated to be April 5, 2011.

3. Calculation of “B” delay

The various beginning and ending dates for “B” delay discussed above are summarized in the tables below.

<u>Beginning of “B” delay</u>	<u>Statute or Rule</u>	<u>Basis</u>
May 14, 2008	35 U.S.C. § 154(b)(2)(B)	actual filing date in the U.S.
May 18, 2008	37 C.F.R. §§ 1.702(b), 1.703(b)	national stage entry
November 10, 2008	37 C.F.R. §§ 1.702(b), 1.703(b)	371(c) compliance
<u>End of “B” delay</u>	<u>Statute or Rule</u>	<u>Basis</u>
July 23, 2010	37 C.F.R. § 1.703(b)(1)	filing of RCE
April 5, 2011	35 U.S.C. § 154(b)(1)(B)	issuance (estimated)

Because the correct basis for the beginning and end of the “B” delay must be governed by the statute, the correct period is from May 14, 2008 until April 5, 2011, or 1057 days. However, this calculation is subject to change based on the actual issue date.

C. Exclusion of Overlapping Delay under 37 C.F.R. § 1.703(f)

Applicants are not entitled to a period of patent term adjustment to the extent that the periods in 37 C.F.R. § 1.702 (*i.e.*, “A” delay and “B” delay) overlap pursuant to 37 C.F.R. §1.703(f) (“Overlapping Delay”). Applicants disagree with the Office’s failure to calculate Overlapping Delay.

The period of “A” delay began on January 10, 2007 and ended on August 6, 2008. The correct period of “B” delay began on May 14, 2008, and ended on April 5, 2011. Thus, the period from May 14, 2008, until August 6, 2008, is overlapping (*i.e.*, 85 days). See *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010).

D. Exclusion of Applicant Delay under 37 C.F.R. §§ 1.703(f) and 1.704

Applicants are not entitled to a period of patent term adjustment to the extent that they failed to engage in reasonable efforts to conclude prosecution of the application pursuant to 37 C.F.R. §§ 1.703(f) and 1.704 (“Applicant Delay”). Applicants agree with the Office’s calculation shown in Exhibit B that the Applicant Delay is 70 days, as detailed immediately below.

With respect to the amendment filed on January 25, 2010, in response to the non-final office action mailed on September 24, 2009, the Applicant Delay is the number of days beginning on the day after the date that is three months after the date of mailing of the office action (*i.e.*, December 25, 2009) and ending on the day that Applicants filed their response (*i.e.*, January 25, 2010), *see* 37 C.F.R., § 1.704(b), which is 32 days.

With respect to the information disclosure statement (“IDS”) filed on March 1, 2010, the Applicant Delay is the number of days beginning on the day after the day that the initial response to office action was filed (*i.e.*, January 26, 2010) and ending on the date that the supplemental reply (IDS) was filed (*i.e.*, March 1, 2010), *see* 37 C.F.R. § 1.704(c)(8), which is 35 days.

With respect to the additional information disclosure statement (“IDS”) filed on March 4, 2010, the Applicant Delay is the number of days beginning on the day after the day that the previous IDS was filed (*i.e.*, March 2, 2010) and ending on the date that the supplemental reply (additional IDS) was filed (*i.e.*, March 4, 2010), *see* 37 C.F.R. § 1.704(c)(8), which is 3 days.

Accordingly, the total period of Applicant Delay under 37 C.F.R. §§ 1.703(f) and 1.704 is 32 days plus 35 days plus 3 days, or 70 days.

E. Total Patent Term Adjustment

Pursuant to 37 C.F.R. § 1.703(f), the total patent term adjustment is 575 days of “A” delay, plus 1057 days of estimated “B” delay, minus 85 days of Overlapping Delay, minus 70

days of Applicant Delay, for a total of 1477 days. However, this calculation is subject to change based on the actual issue date.

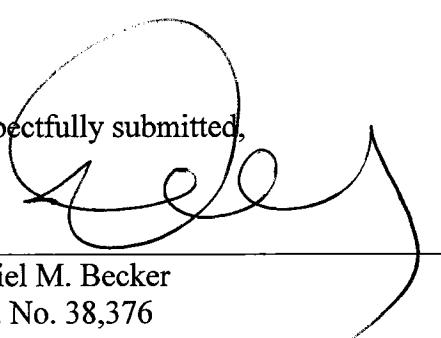
F. Conclusion

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of 1477 days, which may be extended or reduced based on the actual date of issuance of a patent for the above-referenced application.

Date: *November 2, 2010*

DECHERT LLP
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Respectfully submitted,



Daniel M. Becker
Reg. No. 38,376

Exhibit A: Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) attached to the Notice of Allowance

Exhibit B: The Office's calculation of 505 days, printed from PAIR

A

**Attorney Docket No. 383988-006US (109599)
Serial No. 10/534,692**



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/534,692	11/09/2005	Avigdor Scherz	383988-006US (109599)	8697		
37509	7590	09/22/2010	EXAMINER			
DECHERT LLP P.O. BOX 390460 MOUNTAIN VIEW, CA 94039-0460				WARD, PAUL V		
		ART UNIT		PAPER NUMBER		
				1624		
DATE MAILED: 09/22/2010						

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 505 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 505 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

B

**Attorney Docket No. 383988-006US (109599)
Serial No. 10/534,692**

10/534,692 WATER-SOLUBLE ANIONIC BACTERIOCHLOROPHYLL DERIVATIVES AND THEIR USES 10-31-2010::13:40:47

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/534,692

Filing or 371(c) Date:	11-09-2005	Overlapping Days Between {A and B} or {A and C}:	0
Issue Date of Patent:	-	Non-Overlapping USPTO Delays:	575
A Delays:	575	PTO Manual Adjustments:	0
B Delays:	0	Applicant Delays:	70
C Delays:	0	Total PTA Adjustments:	505

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
80	09-22-2010	Mail Notice of Allowance			0
79	09-17-2010	Issue Revision Completed			0
78	09-17-2010	Document Verification			0
77	09-17-2010	Notice of Allowance Data Verification Completed			0
76	09-17-2010	Notice of Allowability			0
74	07-23-2010	Information Disclosure Statement considered			0
73	08-02-2010	Email Notification			0
72	08-02-2010	Change in Power of Attorney (May Include Associate POA)			0
71	07-29-2010	Correspondence Address Change			0
70	07-23-2010	Request for Continued Examination (RCE)			0
69	07-28-2010	Disposal for a RCE / CPA / R129			0
68	07-23-2010	Reference capture on IDS			0
67	07-23-2010	Information Disclosure Statement (IDS) Filed			0
66	07-23-2010	Information Disclosure Statement (IDS) Filed			0
65	07-23-2010	Workflow - Request for RCE - Begin			0
64	04-26-2010	Mail Final Rejection (PTOL - 326)			0
63	04-26-2010	Final Rejection			0
59	03-01-2010	Information Disclosure Statement considered			0
57	03-04-2010	Information Disclosure Statement considered			0
56	03-04-2010	Electronic Information Disclosure Statement	38	49	49
55	03-01-2010	Electronic Information Disclosure Statement			0
54	03-04-2010	Information Disclosure Statement (IDS) Filed			0
51	03-01-2010	Information Disclosure Statement (IDS) Filed			0
50	02-20-2010	Date Forwarded to Examiner			0
49	01-25-2010	Response after Non-Final Action	32	47	47
48	01-25-2010	Request for Extension of Time - Granted			0
47	09-24-2009	Mail Non-Final Rejection			0
46	09-23-2009	Non-Final Rejection			0
43	07-21-2009	Date Forwarded to Examiner			0
42	06-18-2009	Response to Election / Restriction Filed			0
41	06-18-2009	Request for Extension of Time - Granted			0
40	03-19-2009	Mail Restriction Requirement			0

39	03-16-2009 Requirement for Restriction / Election	0
35	01-26-2009 Date Forwarded to Examiner	0
34	01-15-2009 Response to Election / Restriction Filed	0
33	06-28-2006 Corrected filing receipt	0
30	12-17-2008 Mail Restriction Requirement	0
29	12-16-2008 Requirement for Restriction / Election	0
26	10-17-2008 Date Forwarded to Examiner	0
25	10-06-2008 Response to Election / Restriction Filed	0
24	10-06-2008 Request for Extension of Time - Granted	0
23	08-06-2008 Mail Restriction Requirement	575
22	08-04-2008 Requirement for Restriction / Election	0
21	11-09-2005 Information Disclosure Statement considered	0
17	03-24-2006 IFW TSS Processing by Tech Center Complete	0
16	11-09-2005 Reference capture on IDS	0
15.7	11-09-2005 Information Disclosure Statement (IDS) Filed	0
15	11-09-2005 Information Disclosure Statement (IDS) Filed	0
13	11-09-2005 Preliminary Amendment	0
12	03-24-2006 Case Docketed to Examiner in GAU	0
11	03-22-2006 Cleared by OIPE CSR	0
10	11-09-2005 371 Completion Date	0
9	02-14-2006 Application Dispatched from OIPE	0
8	02-14-2006 Notice of DO/EO Acceptance Mailed	0
7	11-09-2005 Additional Application Filing Fees	0
5	11-09-2005 Preliminary Amendments	0
4	11-09-2005 A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	0

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